

REMARKS

This paper is responsive to an Office Action dated May 4, 2005. Prior to this response, claims 1-25 were pending. After amending claims 1, 4-5, 10-14, 17-18, and 22-25, and canceling claims 2-3 and 15-16, claims 1, 4-14, and 17-25 remain pending.

The Office Action states that claims 1-6, 8-9, 12-21, and 24-25 have been rejected under 35 U.S.C. 102(b) as anticipated by AuClair (US 5,659,670). With respect to independent claims 1 and 14, the Office Action states that AuClair describes all the claim limitations, including a user's ability to change memory allocations. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In his Abstract and Summary (col. 2, ln. 19-48), AuClair describes a random access memory (RAM) for storing data in variably sized compartments, and a processor that generates compartment size allocation recommendations in response to source of the print jobs. At col. 8, beginning at ln. 6, AuClair describes a printer that is able to analyze and implement system 100 RAM functions related to printer operations. The various blocks in Fig. 1 show an analytical process that attempts to gauge future memory needs by reviewing the history of previous jobs, cross-referenced to input port (serial, parallel, and network). As noted in the Office Action, decision block 130 permits a user to automatically

change memory allocation, or display recommended allocations for user selection (col. 8, ln. 41-45).

To clarify the present invention, claims 1 and 14 have been amended to recite that the claimed invention MFP RAM can be allocated on the basis of MFP component. That is, RAM can be selectively allocated for the different fax, scan, printer, and copier functions associated with an MFP. As noted above, AuClair is able to allocate RAM on the basis of source (input port), but he does not describe RAM allocation on the basis of MFP component. Further, claims 1 and 14 now recite that RAM allocation can be made on the basis of the document format. AuClair does not describe the allocation of RAM on the basis of document format.

Therefore, AuClair does not describe every limitation of claims 1 and 14. Since AuClair does not explicitly describe all the limitations of claims 1 and 14, he cannot anticipate these claims. Claims 4-6, 8-9, and 12-13, dependent from claim 1, and claims 17-21 and 24-25, dependent from claim 14, enjoy the same distinctions from the cited prior art and the Applicant requests that the rejection be removed.

The Office Action states that claims 7 and 19 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to AuClair, in view of Venkatraman et al. ("Venkatraman"; US 5,956,487). The Office Action acknowledges that AuClair does not describe a web server, but that Venkatraman does. The Office Action continues that it would have been obvious to modify AuClair per Venkatraman because of low cost, enhanced interface functions, and device management, which are AuClair's stated objectives. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

As noted above, AuClair describes a printer that is able to predict memory needs based upon an analysis of the printer job source. The user is then presented with selectable memory allocation options. Generally, Venkatraman describes a web access functionality that can be embedded in a device to improve access and the user interface (col. 2, ln. 33-41).

With respect to the first *prima facie* requirement, the motivation to combine cannot be based upon a desired result of lowering cost, or vague goals such as improving the user interface or device management, as suggested in the Office Action. Rather, the motivation must come from a process detail of the Venkatraman system that can be applied to the AuClair system. Further, even if an actual motive for combining references can be found, that motivation could not suggest a modification to AuClair that makes the claimed invention obvious. At best, the combination of references may suggest a web-accessible MFP.

The issue of motivation does not concern itself with a retrospective desire to combine features from different inventions. If it did, then any two references could be combined merely as the result of a common keyword. Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion of motivation in the references to do so.” *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). Here, the analysis must determine if there is any motivation in the Venkatraman reference to modify AuClair in such a manner as to teach the claimed invention. However, no such analysis has been provided in the Office Action, and the Venkatraman reference suggests no such modification.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the AuClair and Venkatraman inventions as a foundation, there is no reasonable expectation that this expert could derive the claimed invention, since neither reference describes an invention where RAM allocation is based upon MFP component or document format.

With respect to the third *prima facie* requirement, even if an expert would be motivated to combine the two references, the combination does not describe all the limitations of the claimed invention. As noted above in response to the anticipation rejection, AuClair does not describe the limitations of RAM being allocated on the basis of MFP component (fax, scanner, printer, or copier), or on the basis of document format. Venkatraman does not teach anything to do with an MFP or RAM allocation. Therefore, the combination of Venkatraman with AuClair does not explicitly teach RAM allocation based upon MFP component or document format, as recited in claims 1 and 14. Neither does the

Venkatraman suggest any modifications to AuClair that would make these limitations obvious. Claim 7, dependent from claim 1, and claim 19, dependent from claim 14, enjoy the same distinctions from the cited prior art references and the Applicant requests that the rejection be removed.

The Office Action states that claims 10 and 22 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to AuClair, in view of Mahmoud et al. ("Mahmoud"; US 6,785,746). The Office Action acknowledges that AuClair does not describe a user rebooting the system to assign memory, but that Mahmoud describes computer rebooting. The Office Action continues that it would have been obvious to modify AuClair in light of Mahmoud, because rebooting would load the system configuration in RAM, which is a feature demanded by AuClair. This rejection is traversed as follows.

Generally, Mahmoud describes the control of a peripheral device using a multi-channel SCSI chip. At col. 9, ln. 20-24, Mahmoud states that his computer must be rebooted to input data in EEPROM memory. With respect to the first and second *prima facie* requirements, it is not apparent how Mahmoud's treatment of computer rebooting has any relevance to a system that predicts memory allocation based on an analysis of input port (AuClair), except in retrospect.

However, the obviousness rejection can be traversed by considering just the third *prima facie* requirement. Even if an expert would be motivated to combine the two references, the combination does not describe all the limitations of the claimed invention. As noted above in response to the anticipation rejection, AuClair does not describe the limitations of RAM being allocated on the basis of MFP component, or on the basis of document format. Neither does Mahmoud teach any details

in the art of MFPs or discuss the subject of RAM allocation. Therefore, the combination of Mahmoud with AuClair does not explicitly teach RAM allocation based upon MFP component or document format, as recited in claims 1 and 14. Neither does the Mahmoud suggest any modifications to AuClair that would make these limitations obvious. Claim 10, dependent from claim 1, and claim 22, dependent from claim 14, enjoy the same distinctions from the cited prior art references and the Applicant requests that the rejection be removed.

The Office Action states that claims 11 and 23 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to AuClair, in view of Bitar et al. ("Bitar"; US 6,353,844). The Office Action acknowledges that AuClair does not describe MFP functions being prioritized in the event of memory contention. However, the Office Action states that Bitar describes CPU and memory resources that can be allocated for each batch job (col. 11, ln. 32). The Office Action continues that it would have been obvious to modify AuClair in light of Bitar because allocating resources to higher priority functions would improve the printer response time. This rejection is traversed as follows.

With respect to the first and second *prima facie* requirements, it is not apparent how Bitar's allocation of resources on the basis of batch job suggests any modifications to AuClair's memory allocation, which is based on an analysis of input port. Neither is a desire to improve printer response time a suggestion that AuClair can be modified in light of Bitar. It is not apparent how Bitar's teachings can be applied to AuClair. These references can only be combined in retrospect.

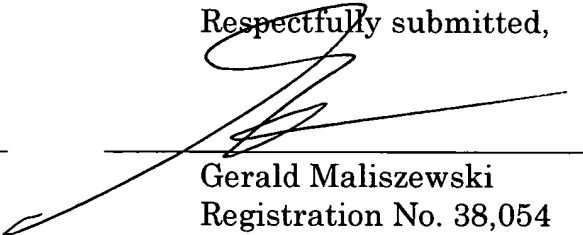
With respect to the third *prima facie* requirement, even if an expert would be motivated to combine the two references, the combination

does not describe all the limitations of the claimed invention. AuClair does not describe the limitations of RAM being allocated on the basis of MFP component, or on the basis of document format. Neither does Bitar teach any details in the art of MFPs or discuss the subject of RAM allocation. Therefore, the combination of Bitar with AuClair does not explicitly teach RAM allocation based upon MFP component or document format, as recited in claims 1 and 14. Neither does Bitar suggest any modifications to AuClair that would make these limitations obvious. Claim 11, dependent from claim 1, and claim 23, dependent from claim 14, enjoy the same distinctions from the cited prior art references and the Applicant requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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